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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,666	04/05/2001	Joseph Herbert McIntyre	AUS920010220US1	3499

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EXAMINER

AGDEPPA, HECTOR A

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 03/26/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,666

Applicant(s)

MCINTYRE, JOSEPH HERBERT

Examiner

Hector A. Agdeppa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2001 and 27 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 – 31 are provisionally rejected under the judicially created doctrine of double patenting over claim 1 - 35 of copending Application No. 09/826,663. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Both applications claim a method and system of call forwarding wherein a call may be transferred from a first telephone number to a second telephone number dependent upon a choice or preference made by a user receiving the incoming calls.

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Furthermore, both applications claim the same embodiments, i.e., wireless devices, pagers, computers, laptops, etc. Finally, both applications claim the same configuration/component makeup in the claimed apparatuses.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3, 4, 6, 10 – 12, 16, 18, 19, 21, and 25 - 27 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,160,877 (Tatchell et al.)

As to claims 1 and 16, Tatchell et al. teaches a call forward feature wherein the personal agent 11 allows the subscriber to direct incoming calls to one of a plurality of subscriber numbers to their current location or some other predetermined location. (Abstract, Col. 9, line 29 – Col. 12, line 19, Col. 18, line 55 – Col. 22, line 33) Tatchell et al. also teaches that the subscriber, via personal agent 11, can invoke another feature

which allows for a subscriber to receive an announcement as to, for example, the identity of the calling party. The subscriber may then choose whether to accept, reject, or redirect the call, wherein the redirection is read as the claimed routing information. (Col. 19, lines 16 – 52, Col. 21, line 19 – Col. 22, line 20)

As to claims 3 and 18, Tatchell et al. teaches that when an incoming call is received, personal agent 11 will access the subscriber's personal database(s), i.e., contact databases, call routing preferences, announcement preferences, etc. Moreover, Tatchell et al. teaches that the subscriber, via, his/her user device, a telephone, wired or mobile, may access the above mentioned databases and preferences to provision them as desired. (Col. 6, line 65 – Col. 8, line 56, Col. 9, lines 21 – 63, Col. 10, line 36 – Col. 12, line 14, Col. 13, line 54 – Col. 19, line 27)

As to claims 4, 6, 19, and 21, see the above rejection of claims 3 and 18. A mobile telephone is both wireless and cellular.

As to claims 10, 11, 25, and 26, Tatchell et al. teaches that in a pass through mode, personal agent 11 will not intercept or answer the call but will allow a call to pass. And if a busy or no answer situation arises, personal agent 11 will redirect the call to voice mail. (Col. 19, lines 20 – 27)

As to claims 12 and 27, Tatchell et al. teaches that various announcements may be played to a caller depending on the subscriber's predetermined preferences. (Col. 19, line 28 – Col. 20, line 11)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2, 5, 7 – 9, 13 – 15, 17, 20, 22 – 24, 28 – 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,160,877 (Tatchell et al.)

As to claims 2, 5, 17, and 20, Tatchell et al. has been discussed above. What Tatchell et al. does not teach is where redirection is transferring the incoming call to a second number. Tatchell et al. teaches that when personal agent 11 receives a redirection response from the subscriber, the call is transferred to voice mail. Because Tatchell et al. teaches that the voice mail system 35 need not be integrated to personal agent system 11, (Col. 11, lines 5 – 10) redirection to the voice mail system could involve redirection to a second number, i.e., the number corresponding to the voice mail system).

Interpreted in another manner, however, it still would have been obvious for one of ordinary skill in the art at the time the invention was made to have allowed the subscriber to respond to the above discussed announcement with a call forward command and indicating what number to forward the incoming call to. This is because Tatchell et al. merely teaches that personal agent 11 will already know where the subscriber is currently located (see the above rejection of claims 1 and 17) or already knows to what number a subscriber wants any incoming calls forwarded to. In other

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words, the invention of Tatchell et al. differs only in when the call forwarding information is known/given. The end result is the same, the subscriber can choose to where he/she would like incoming calls forwarded to and is given the option at call reception to decide how a call is to be routed.

As to claims 7 – 9 and 22 - 24, Tatchell et al. does not teach using a pager or wireless computing device/laptop to access personal agent 11. However, in modern telecommunications systems, the integration of various types of telephony and computer devices is very old and well known such as wireless personal digital assistants (PDAs) or laptops with wireless communication capabilities. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have contemplated using other devices besides strictly telephony devices to interact with personal agent 11. Tatchell et al. as discussed above, already contemplates using both landline and wireless telephones as well as receiving data and fax communications in addition to just voice communications. (Col.4 , line 34 and Col. 14, line 34, Col. 19, line 34)

As to claims 13 – 15 and 28 – 30, Tatchell et al. has been discussed above. What Tatchell et al. does not teach is routing an incoming call to voice mail if no routing response is received within a predetermined period or there is an invalid second number received. Tatchell et al. also does not teach validating a second, forward-to, number.

However, such features are very old and well known in the art. As to the no-response and invalid second number features, such are merely default routing

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conditions. Tatchell et al. teaches default routing to voice mail for example, when a caller is not one of a plurality of predetermined special groups of callers from whom a subscriber will accept calls. (Abstract, Col. 3, line 23 – Col. 4, line 29, Col. 16, line 48 – Col. 19, line 15) Tatchell et al., as already discussed above, also teaches that if a no answer or busy situation arises, a call is defaulted to voice mail. A no answer or busy is condition is analogous to not receiving a routing response at all.

The same is true of validating numbers before connecting calls thereto. It is a waste of resources and processing power of a system to connect a call to an invalid number. It is also annoying to callers to be forwarded to an invalid number.

For the above reasons, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have incorporated such features into the invention of Tatchell et al. inasmuch as their inclusion does not teach away from Tatchell et al, nor would they affect the operation of Tatchell's personal agent 11.

As to claim 31, see the rejection of claims 1, 2, 5, 17, and 20. Furthermore, personal agent 11 has therein, at least, a processor 21 and various databases which communicate with each other. (Fig. 2a) Databases and processors are not the same type of elements, nor do they perform the same operations. As such, it is inherent that a network interface would have to be used to allow for those two different types of elements to interact.

What Tatchell et al. does not teach is the use of a system bus. However, system busses are extremely old and well known and merely allow different components of a system to be connected to a common link allowing for communication therebetween.

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Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have implemented personal agent 11 of Tatchell et al. in manner that utilized a system bus. The functionality and operation of personal agent 11 would not be affected by the use of a system bus as opposed to separate connections between the databases 22 and the processor 21. Moreover, Tatchell et al. does not even describe the type of connections used in personal agent 11. It could very well be that a system bus is used.

Conclusion


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector A. Agdeppa whose telephone number is 703-305-1844. The examiner can normally be reached on Mon thru Fri 9:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.A.A.
March 7, 2004


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